

3/12/02

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Paper No. 12  
ejs

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re The Valspar Corporation

Serial No. 75/814,381

Kristina M. Foudray of Merchant & Gould PC for The Valspar Corporation.

Brian A. Rupp, Trademark Examining Attorney, Law Office 105  
(Thomas G. Howell, Managing Attorney)

Before Simms, Seeherman and Chapman, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The Valspar Corporation has appealed from the final refusal of the Trademark Examining Attorney to register ELECTROGARD as a trademark for "protective and decorative coatings applied by electro-deposition application in the

nature of industrial finishes."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the marks listed below, which are registered by two different entities, as to be likely, if applied to applicant's identified goods, to cause confusion or mistake or to deceive:

ELEKTROGUARD for "silicone elastomers for electrical coatings potting compounds, encapsulants and silicone gels";<sup>2</sup> and

ELECTRI-GUARD for "anti-corrosion coating for the protection of electrical connections."<sup>3</sup>

The appeal has been fully briefed; applicant did not request an oral hearing.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between

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<sup>1</sup> Application Serial No. 75/814,381, filed October 4, 1999, based on an asserted bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 1,621,851 issued November 13, 1990; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

<sup>3</sup> Registration No. 2,152,035, issued April 21, 1998.

the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**,  
544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the marks, applicant's mark ELECTROGARD is virtually identical to the cited marks, ELEKTROGUARD and ELECTRI-GUARD, in pronunciation, and it is very similar in appearance, although we acknowledge that there are minor differences in spelling, and that the "K" in ELEKTROGUARD might, because of the misspelling, be noticeable, and the hyphenation in ELECTRI-GUARD might cause the two words making up that mark to stand out. There are some differences in connotation, in that the prefix ELECTRO/ELEKTRO/ELECTRI in the respective marks suggests different things because of the goods with which each mark is used. Specifically, in applicant's mark ELECTRO would be perceived as referring to the manner in which the coatings are applied, while in ELEKTROGUARD it would refer to the electrical coatings, and in ELECTRI-GUARD it would indicate the use in protecting electrical connections.

We also note that the cited marks must, because of their highly suggestive nature, be treated as weak marks which are entitled to a limited scope of protection. As applicant points out, the record supports the weakness of the marks, in view of the fact that the ELECTRI-GUARD

registration issued despite the existence on the register of the ELEKTROGUARD registration, while the ELEKTROGUARD registration, and in some cases, the ELECTRI-GUARD registration coexisted on the register at one point with other ELECTRO-prefix marks for various coatings. Although we do not have the records of these files before us, and therefore cannot determine what factors went into the decisions to allow the registrations, the registrations do show that ELECTRO, in particular, is a highly suggestive term for such goods.

With respect to the goods, there are clear differences between applicant's protective and decorative coatings, applied by electro-deposition application, in the nature of industrial finishes, and the "anti-corrosion coating for the protection of electrical connections" identified in the ELECTRI-GUARD registration. The Examining Attorney, while candidly admitting that he possesses no special knowledge about the industry, claims that the term "industrial finishes" is extremely vague and broad,<sup>4</sup> and that "protective and decorative coatings" would encompass

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<sup>4</sup> We note that the Examining Attorney accepted applicant's proposed identification of goods. If, indeed, the Examining Attorney believed that "industrial finishes" is extremely vague, he should have required a more definite identification of goods or information regarding applicant's goods. We would add that we see no infirmity with the identification.

"anti-corrosion coating" while coatings for "industrial finishes" would encompass "coating for the protection of electrical connections." Although it is true that the likelihood of confusion analysis must be based on the goods as they are identified in the application and the cited registration, we think the Examining Attorney goes too far in both parsing the applicant's and registrant's identifications and in merely assuming that coatings for industrial finishes would encompass coatings for the protection of electrical connections. There is no evidence in the record that would allow us to draw such a conclusion. Certainly the dictionary definitions for "industrial" and "finish" that the Examining Attorney asks us to judicially notice do not support this position. Nor is there any evidence that anti-corrosion coating for the protection of electrical connections could be applied by electro-deposition, or that protective coatings applied by electro-deposition and which are in the nature of industrial finishes would or could be used for the protection of electrical connections.

The Board has previously stated that the fact that the goods of the parties can be described by a particular word is not a sufficient basis for finding the goods to be related. See **Harvey Hubbell Incorporated v. Tokyo Seimitsu**

**Co., Ltd.**, 188 USPQ 517 (TTAB 1975) ("the mere fact that the term 'electronic' can be used to describe any product that includes an electronic device does not make a television set similar to an electronic microscope, or an electronic automotive ignition system similar to telemetering devices"); **In re Cotter and Company**, 179 USPQ 828 (TTAB 1973). However, that is what the Examining Attorney would have us do, if we were to conclude that "protective and decorative coatings applied by electro-deposition application in the nature of industrial finishes" encompass "anti-corrosion coating for the protection of electrical connections."

Similarly, the record does not support a finding that applicant's goods and the "silicone elastomers for electrical coatings potting compounds, encapsulants and silicone gels" which are identified in the ELEKTROGUARD registration are related. We should acknowledge, as the Examining Attorney did with respect to applicant's goods, that the nature of this registrant's goods is not entirely clear to us. It appears to us that there is a typographical error consisting of a missing comma in the identification, and that the goods should be identified as "silicone elastomers for electrical coatings, potting compounds, encapsulants and silicone gels"; in other words,

the registrant's goods are silicone elastomers which are used for a variety of items. This conclusion is supported by the fact that the goods are classified in Class 1, the chemicals class, and not in Class 2, which is the appropriate classification for coatings such as applicant's and the ELECTRI-GUARD registrant's goods.

Although the Examining Attorney contends that the wording "protective and decorative coatings" in applicant's identification could encompass silicone elastomers, that assertion is not supported by the record, and is contradicted by applicant. As applicant points out, an elastomer is "any of various elastic substances resembling rubber."<sup>5</sup> Applicant's goods, on the other hand, are specifically identified as being "applied by electro-deposition application" and therefore they cannot be elastomers.

It must also be remembered that the goods in the application and the cited registrations are all products which are purchased with a degree of care by people sophisticated in the industry. Such purchasers are not likely to believe that protective and decorative coatings

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<sup>5</sup> Merriam Webster's Collegiate Dictionary, submitted with applicant's reply brief. The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

applied by electro-deposition application in the nature of industrial finishes come from the same source as silicone elastomers for electrical coatings, or from the same source as coating for the protection of electrical connections simply because the goods are all used in a coating process. Moreover, there is no evidence that applicant's goods and the goods in the cited registrations would be used for the same purposes or that they would be sold to the same class of purchasers.

In reaching our conclusion that there is no likelihood of confusion, we have considered the third-party registrations submitted by the Examining Attorney, but do not find them to be persuasive. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993). However, our review of the third-party registrations does not reveal identifications which cover both the goods identified in applicant's application and those identified in either of the cited registrations. Similarly, the evidence from applicant's website that indicates applicant's mission "is to be the recognized leader in the coatings industry" and



that it is "one of the five largest North American manufacturers of paints and coatings" is not sufficient to prove that applicant's identified coatings are related to the goods in the cited registrations. Nor can we find that consumers will assume a common source simply because applicant is a large company which sells a wide variety of coatings. There is no evidence from the website that indicates either that applicant makes coatings such as the registrants', or that applicant markets its different coatings under the same product mark.

Decision: The refusals of registration with respect to Registration Nos. 1,621,851 and 2,152,035 are reversed.